

**REMARKS**

Applicant would note that in view of cancellation of claims 25-27, 30-32 and 34, the pending claims 20-21, 23-24, 28, 29, and 35 are believed to conform to the single invention as defined by the Examiner. The subject matter of claim 22 has been incorporated into independent claim 20. Therefore, claim 22 has also been canceled.

**Rejection under 35 U.S.C. 102(b):**

The Examiner has rejected claims 20-21, 24 and 35 as being unpatentable over Paton (2788809).

Initially, applicant would note that the subject matter of claim 22 has now been incorporated into independent claim 20. The Examiner has acknowledged at page 5 of the most recent Office action that Paton does not disclose the valve being suspended from below the support frame as now required by amended claim 20. Thus, the reference does not disclose each and every element of the presently claimed invention.

Applicant would further note that the device disclosed by Paton is designed for a different purpose, and that the presently amended claims require a number of features that are not disclosed in Paton. We note that the amendments submitted above are to further distinguish the invention from the citations.

Paton describes a valve mechanism for controlling measured quantities of material. That is, the “controlling” of the discharge is directed at a mechanism for discharging accurate and measured quantities of material, and the hopper must open and fully close the discharge outlet to obtain measured quantities of material.

The present invention does not control the amount of material being discharged, and the discharge outlet is open to the surrounding environment and is unimpeded and

open except for the bulb. The bulb is configured and arranged so that the column of material forming at the discharge outlet is uniform. Further, no conduit or pipe closes in the discharge outlet of the present invention as claimed as the flowable material exits the hopper to an open discharge pile. The present hopper controls the flow of material being discharged so that the amount of dust being dispersed through an open discharge outlet (open to the surrounding environment) is reduced. Proposed claim 20 now includes a number of specific limitations to such a design of hopper.

Applicant would further note that the present invention does not stop/control the flow of material as the hopper of the invention is designed to discharge all the material being gravity fed into and through the hopper, and discharged through an “open” discharge outlet onto a discharge pile.

It is seen that US 2,788,809 (Paton) describes in figure 3 a funnel conduit 33 under the discharge outlet of the hopper. This is more of a closed hopper design with a closed in discharge outlet. Further, it is this conveyor trough/funnel conduit 33 that is lifted to open the valve seat 19 and allow a measured amount of material to be discharge through the closed conduit pipe 33 and lowered to close the valve seat 19.

In claim 20, the limiting features of a flowable material being conveyed through the hopper until the in-flow of material to the hopper is stopped or ends; the area directly below and about the open discharge outlet being open to the surrounding environment; flowable material is discharged through an open discharge outlet; and the material forming a column of flowing material, are all features not disclosed in Paton reference, and as a whole such combination of features are not obvious to one skilled in the art. The

result of reducing the amount of dust dispersed into the surrounding environment would be not reduced by removing the funnel in the outlet path, and in any case, the Paton invention would be defeated if the funnel 33 is removed.

Applicant would urge that anticipation requires the disclosure, in a single prior art reference, of each element of the claim under consideration. W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Here, claim 16, and the claims dependent thereon, includes a specific limitation which Webster ('975) fails to describe or disclose. Thus, with regard to the presently claimed subject matter the reference relied upon fails to disclose every limitation present in the claims and therefore can not reasonably be said to anticipate the claimed invention within the meaning of 35 U.S.C. 102(b).

Thus, applicant would request reconsideration and withdrawal of this rejection.

#### **Rejections under 35 U.S.C. 103:**

The Examiner has rejected claim 22 as unpatentable over the combination of Paton taken in view of Barger.

In view of the cancellation of claim 22 and the remarks above relating to the amended claims, applicant would request withdrawal of this ground of rejection.

Applicant would note that the Barger reference does not have all the elements of old claim 22 or new amended claim 20 (incorporating the features of claim 22). US 4,410,111 (Barger) relates to a storage container or tank with a cone designed to block or seal the discharge port. This invention is not a hopper or directed at a specific hopper design, the difference being that the hopper is designed as a discharging vessel, and the storage tank is designed to store materials. The inventions are designed and constructed

for two different purposes. Barger discloses an inverted cone, not a bulb. The cone is designed to close the discharge port when required. The references to the cone valve providing a uniform flow is to provide an even discharge of material, particularly when different layers of material have been stored in the storage container. There is no teaching that the inverted open cone valve is designed to suppress and reduce the amount of dust being discharged into a column into the surrounding environment, and it is not designed for this purpose, and would not serve this purpose at all.

Thus, a combination with Paton is not appropriate and would not have been obvious to one of ordinary skill in this particular art area.

The Examiner has, also, rejected claim 28 as unpatentable over Paton alone.

Applicant would note that claim 28 now depends directly from newly amended claim 20. As discussed fully in regard to the rejection under 35 U.S.C. 102 based on the Paton reference, the reference fails to disclose or account for many of the limitations of the currently pending claim 20. Since 28 depends therefrom, it is clear that these limitations, not taught or suggested by Paton, are included in claim 28. For these reasons, applicant requests reconsideration and withdrawal of this ground of rejection.

Applicant respectfully requests, if the claims are again rejected upon any combination of references, that the Examiner include an explanation, in accordance with M.P.E.P. § 706.02. Ex parte Clapp, 27 U.S.P.Q. 972 (P.O.B.A. 1985), and Ex parte Levengood, *supra*, a “factual basis to support his conclusion that would have been obvious” to make the combination.

The applicant would like to bring the attention of the examiner that in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. As mentioned above, none of

references cited by the Examiner alone or in combination would have made the whole invention obvious over the prior art. The Supreme Court's decision in *KSR International Co. v. Teleflex, Inc., et al.*, 550 U.S.(2007) requires that an Examiner provide "some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness." (KSR Opinion at p. 14). An Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does," (KSR Opinion at p. 15). And, the Examiner must make "explicit" this rationale of "the apparent reason to combine the known elements in the fashion claimed," including a detailed explanation of "the effects of demands known to the design community or present in the marketplace" and "the background knowledge possessed by a person having ordinary skill in the art." (KSR Opinion at p. 14). Anything less than such an explicit analysis may not be sufficient to support a prima facie case of obviousness. In January 2008 BPAI decision entitled *In re Wada and Murphy* reversed a § 103 rejection because the Examiner did not explain where or how cited art taught or suggested all of the features of a claimed invention.

As noted above that the Office Action fails to specifically address even the expressly recited features of the pending independent and dependent claims. Under the Office's policy of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application. (MPEP §707.07(g)). It is submitted that the present application is not sufficiently informal, does not present an undue multiplicity of claims, or exhibit a misjoinder of inventions, so as to reasonably preclude a complete action on the merits. Thus, it is submitted that the Office's failure constitutes a failure to expeditiously provide the information necessary to resolve issues related to patentability that prevents the Applicant from, for example, presenting appropriate patentability arguments and/or rebuttal evidence. (See The Official Gazette Notice of November 7, 2003). Additionally, it is submitted that the Office's failure needlessly encourages piecemeal prosecution, which is to be avoided as much as possible. (MPEP §707.07(g)). Accordingly, in the event that the Office maintains the rejection of any of the independent and/or dependent claims, Applicant respectfully requests, in the interests of compact prosecution, that the Office apply art against each feature of each rejected independent and dependent claims, on the

record, and with specificity sufficient to support a prima facie case of obviousness.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

It is well known that in order for any prior-art references themselves to be validly combined for use in a prior-art § 103 rejection, *the references themselves* (or some other prior art) must suggest that they be combined. E.g., as was stated in *In re Sernaker*, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983):

“[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantages to be derived from combining their teachings.” That the suggestion to combine the references should not come from applicant was forcefully stated in *Orthopedic Equipment Co. v. United States*, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983):

“It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO].” As was further stated in *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), “[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself  
... *Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*” [Emphasis supplied.]

In line with these decisions, the Board stated in *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (P.T.O.B.A.&I. 1993):

“In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the, applied references in the proposed manner to arrive at the claimed invention. ...

That which is within the capabilities of one skilled in the art is not synonymous with obviousness. ... That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of the ordinary skill in the art to combine the teachings of the references to make the claimed invention.... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that 'would lead' that individual 'to combine the relevant teachings of the references.' ... Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."

**Allowable subject matter:**

Applicant acknowledges with appreciation, the indication of allowability of claims 23 and 29. The Examiner makes reference to overcoming rejections under 35 U.S.C. 112, second paragraph. No such rejections were found in the Office action. Applicant has attempted by the newly presented amendments to meet the Examiner's request that these claims be presented in allowable form. The presently submitted amendments are urged to overcome all rejections and objections of record. Therefore it is believed that the claims on which claims 23 and 29 depend are now allowable.

Thus, applicant would urge the Examiner to reconsider the objections and rejections of record and allow all claims currently pending in the application.

Should any official at the United States Patent and Trademark Office deem that any further action by the Applicant or Applicant's undersigned representative is desirable and/or necessary, the official is invited to telephone the undersigned at the number set forth below.

The Commissioner is hereby authorized to charge any fees which may be required regarding this application under 37 CFR §§ 1.16-1.17 or credit any overpayment, to deposit account No. 503321. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, or otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 503321.

Respectfully submitted.

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